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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,599	09/11/2000	Glenn H. McGall	2719.2001-000	4766

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EXAMINER

EPPS FORD, JANET L

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8/17

## Office Action Summary

### Application No.

09/659,599

### Applicant(s)

MCGALL, GLENN H.

### Examiner

Janet L. Epps-Ford, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 30-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-18-03; 10-10-03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-18-03 has been entered.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 103***

2. Claims 1-23, and 30-38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McGall et al. (5,412,087; US'087) in view of McGall et al. (WO 98/39348 A1; WO'98), for the reasons of record set forth in the Office Action mailed 4-09-2003.

3. Applicant's arguments filed 10-12-03 have been fully considered but they are not persuasive. Applicants traverse the instant rejection on the grounds that none of the protecting groups recited in the present claims fall within the core structure of a nitrobenzylic compound. Contrary to Applicant's assertions, although specific nitrobenzylic compounds are described in one particular embodiment of the McGall et al. (US'087) reference, the entirety of the McGall et al. (US'087) reference can not be construed as being limited to wherein the compounds of the invention are limited to the examples of nitrobenzylic compounds (see col. 8, lines 25-33) listed in the McGall et al. (US'087) reference. It is specifically stated that the caging groups used in the method of McGall et al. (US'087) are photoactivatable, wherein cages formed by these groups are photosensitive protecting groups that are activatable by low energy ultraviolet or

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visible light. Moreover, McGall et al. (US'087) state that "the above description is intended to be illustrative and not restrictive," (col. 12, lines 13-21) and that "[C]learly, many photosensitive protecting groups are suitable for use in the present method." (col. 8, lines 34-35) Furthermore, in regards to the "core structure" of nitrobenzylic groups referred to by Applicants, McGall et al. refers to the compounds comprising this structure as "examples of acceptable photosensitive protecting groups." It is clear that the common feature of the nitrobenzylic groups useful in the method of McGall et al. (US'087) is not the core structure referred to by Applicants, but their common utility, specifically the ability to be used as photosensitive protecting groups.

It is clear that compounds of the present invention are encompassed by the "core structure"  $\text{Ar-C(R1)(R2)-O-C(O)-}$  of the compounds taught by McGall et al. (WO'98). Although Applicants argue that the substituents of the aromatic portion of the protecting groups of McGall et al. (WO'98) are preferably electron-donating groups, therefore one of ordinary skill in the art would not be lead to prepare a protecting having an electron withdrawing group such as a nitro group. First it is noted that Applicants are limiting the scope of the McGall et al. reference to one particular embodiment, however it is clear that other substituents into the aromatic ring are also contemplated. Moreover, absent evidence to the contrary, McGall et al. (WO'98) clearly state that substitutions of the Ar group may be mono-, di- or tri-substituted, independently, with alkyl, lower-alkyl, or a nitro group (*inter alia*; see page 6, lines 1-4). These substitutions are all considered to be functionally equivalent substituents that would produce a functional photocleavable group.

Applicant's arguments do not take the place of evidence, that the combination of the McGall et al. (US'087) and McGall et al. (WO'98) references would not have motivated one of

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ordinary skill in the art at the time of filing to modify the teachings of McGall et al. (US'087) et al. with the teachings of McGall et al. (WO'98), in the making of the compounds according to the present invention having a formula according to M-Y, and the methods of attaching a molecule to a support according to the present invention.

4. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford, Ph.D. whose telephone number is 571-272-0757. The examiner can normally be reached on Monday-Saturday, Flex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Janet L. Epps-Ford, Ph.D.  
Examiner  
Art Unit 1635

*JLE*